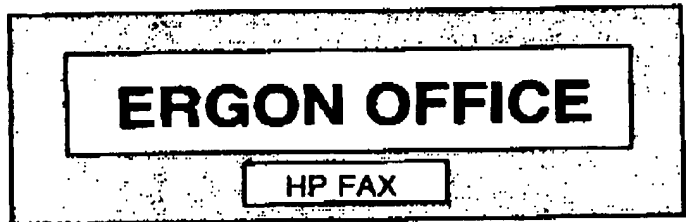


*John*  
*Last 3 pages*

①  
of  
23



11:20

From:

**Dr. Neil C. Schoen**  
  
**Ergon Technology Associates**  
**9817 Freestate Place**  
**Suite #4**  
**Gaithersburg, MD 20879**

To:

UNITED STATES PATENT AND  
TRADEMARK OFFICE  
Alexandria, VA 22313-1450  
  
FAX'd to OFFICIAL phone #

FAX Phone Number:

301-330-5484

FAX Phone Number:

1-571-273-3800 *8360*

Voice Phone Number:

301-330-5484

Voice Phone Number:

1-571-272-6771 (SUPERVISOR)  
*A. Kalinowski*

*2nd copy*

Number Of Pages:

1 + 22

Date/Time:

*4/11/2008 11:10 A.M.*  
*4/7/2008 11:45 P.M.*

Subject:

Examiner: N. Subramanian  
Response to Office Action Summary of 1/16/2008 Re:10/759,145  
and Interview of 4/4/2008

Notes: *Double copy of 2 pages Tot 24 fax'd (out of numerical order)*

Please include the attached *(22)* page response to the above mentioned Office Action Summary. *24 two pages double fax'd (near end)*

Examiner: N. Subramanian      Art Unit: 3691

Thank you,  
*Neil C. Schoen*

# Office Action Summary

Application No.

10/759,145

Applicant(s)

SCHOEN, NEIL C. (2)

Examiner

Narayanswamy Subramanian

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

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## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

Application/Control Number: 10/759,145  
Art Unit: 3691

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Page 2

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# DETAILED ACTION

1. This office action is in response to applicant's communication of January 20, 2004.  
Original claims 1- 4 are pending and have been examined. The objections to the specification and rejections are stated below.

## *Specification*

2. The abstract is objected to by the examiner. Applicant is reminded of the proper content of an abstract of the disclosure. The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The abstract provided exceeds 150 words and is not limited to one paragraph. Correction is required.

## *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1- 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 - 4 recite the limitation "A financial instrument to protect the value of residential real estate". It is not clear to which statutory class the invention belongs. Appropriate clarification/correction is required.

## *Claim Rejections - 35 USC § 101*

5. 35 U.S.C. 101 reads as follows:

add O.K.  
on 4/4/2008 by examiner  
for product  
pg. 2 of 9 + Law-Statutory  
class page

(5)

Page 3

Application/Control Number: 10/759,145

Art Unit: 3691

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-4 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory Subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

A "financial instrument to protect the value of residential real estate" does not belong to any of the above statutory classes.

The steps of the method are untied to another category of statutory subject matter and hence the claimed invention does not qualify as a process under 35 U.S.C 101.

Claims 1-4 of the disclosed invention is inoperative and therefore lacks utility. Claim 2 merely recite elements of an apparatus or a system ("means to" corresponds to software program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e. functional descriptive material per se) and therefore is rendered inoperative lacking any utility. The "means to" functions are interpreted as software. Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor).

Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam* 31 USPQ2d 1754, where the rejection of a claim to a disembodied data structure

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Application/Control Number: 10/759,145

Art Unit: 3691

was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

### Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are listed on the attached form PTO-892.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Narayanswamy Subramanian whose telephone number is (571) 272-6751. The examiner can normally be reached Monday-Thursday from 8:30 AM to 7:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached at (571) 272-6771. The fax number for Formal or Official faxes and Draft to the Patent Office is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*N. Sub*

Dr. N. Subramanian  
Primary Examiner  
Art Unit 3691

January 16, 2008

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PAGE 6/23 : RCVD AT 4/11/2008 11:39:41 AM [Eastern Daylight Time] : SVR:USPTO-EFXXRF-6/41 : DNIS:2738300 : CSID:301 330 5484 : DURATION (mm:ss):09:26

<b>Notice of References Cited</b>	Application/Control No. 10/759,145	Applicant(s)/Patent Under Reexamination SCHOEN, NEIL C.	
	Examiner Narayanswamy Subramanian	Art Unit 3691	Page 1 of 1

U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,360,210	03-2002	Wallman, Steven M. H.	705/36R
*	B	US-7,269,566	09-2007	Elliott, Douglas R.	705/1
*	C	US-5,987,435	11-1999	Weiss et al.	705/36R
*	D	US-6,513,020	01-2003	Weiss et al.	705/36R
*	E	US-2002/0138299	09-2002	Nations, Scott	705/1
*	F	US-2002/0184099	12-2002	Weiss, Allan N.	705/36
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707 05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office  
PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 20080116

5 of 5

# ERGON OFFICE

HP FAX

**From:**

**Dr. Neil C. Schoen**

**Ergon Technology Associates  
9817 Freestate Place  
Suite #4  
Gaithersburg, MD 20879**

**To:**

**Dr N. Subramanian  
Primary Examiner A.U. 3691  
U.S. Patent & Trademark Offc.  
Alexandria, VA 22313-1450**

**FAX Phone Number:**

**301-330-5484**

**FAX Phone Number:**

**1-571-273-6751**

**Voice Phone Number:**

**301-330-5484**

**Voice Phone Number:**

**1-571-272-6751**

**Number Of Pages:**

**1 + 9**

**Date/Time:**

**3/24/2008 → 9:45 PM**

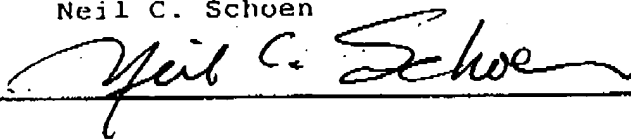
**Subject:**

**Discussion of DRAFT changes for Scheduled Interview**

**Notes:**

Dr. Subramanian-  
Attached are proposed changes to be discussed at a scheduled interview. The Interview Request Form is provided. Please contact me with the proposed date of interview. Please call above phone number to confirm receipt of this FAX.  
Thank you-

Neil C. Schoen



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### Applicant Initiated Interview Request Form

Application No 10/759,145 First Named Applicant: Neil C. Schoen  
Examiner Subramanian, n Art Unit: 3691 Status of Application pending 1st I rs

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**Tentative Participants:**

(1) Dr. Neil C. Schoen (2) \_\_\_\_\_  
(3) \_\_\_\_\_ (4) \_\_\_\_\_

APR 11 2008

Proposed Date of Interview: first week April Proposed Time: TBD (AM/PM)

**Type of Interview Requested:**

(1) ☒ Telephonic (2) ☒ Personal (3) ☐ Video Conference  
\* OR \*

Exhibit To Be Shown or Demonstrated: ☒ YES ☐ NO

If yes, provide brief description: \* Draft revised Claims/Abstract/Objections

### Issues To Be Discussed

Issues (Rej., Obj., etc)	Claims/ Fig. #s	Prior Art	Discussed	Agreed	Not Agreed
(1) <u>Abstract</u>	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(2) <u>Claims</u>	_____	<u>not relied upon</u>	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(3) <u>Specification</u>	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>
(4) _____	_____	_____	<input type="checkbox"/>	<input type="checkbox"/>	<input type="checkbox"/>

☒ Continuation Sheet Attached (8 pages)

**Brief Description of Arguments to be Presented:**

See attached (8 pages)

An interview was conducted on the above-identified application on \_\_\_\_\_.

**NOTE:** This form should be completed by applicant and submitted to the examiner in advance of the interview (see MPEP § 713.01).

This application will not be delayed from issue because of applicant's failure to submit a written record of this interview. Therefore, applicant is advised to file a statement of the substance of this interview (37 CFR 1.133(b)) as soon as possible.

Neil C. Schoen  
Applicant/Applicant's Representative Signature

\_\_\_\_\_  
Examiner/SPI Signature

Dr. Neil C. Schoen

Typed/Printed Name of Applicant or Representative

64260 (Customer #)

Registration Number, if applicable

This collection of information is required by 37 CFR 1.133. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 20 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2

2 of 2